

REMARKS

Claims 130-152 and 161-171 are pending. Claims 130-133, 137 and 141-143 have been amended. Claims 158-160 have been canceled without prejudice or disclaimer. Claims 161-171 are new. No new matter is added by the amendments. Applicants reserve the right to file one or more divisional applications to any canceled subject matter.

Claims 130-133, 137 and 141-143 have been amended to recite phosphates or pharmaceutically acceptable salts or esters thereof. Support for these amendments are found in the specification, for example, at page 21, lines 1-3; page 23, lines 6-7 and 22; page 26, lines 6-8 and 20-21; and page 54, lines 18-31.

New claim 161 recites a phosphate of the compound of claim 130. Support for this claim is found, for example, in the specification at page 23, lines 6 and 22; and page 26, lines 7 and 23.

New claims 162 and 164 recite cytidine nucleosides. Support for these claims is found, for example, in the specification at page 39, lines 10-11.

New claims 163 and 165 recite guanosine nucleosides. Support for these claims is found, for example, in the specification at page 39, lines 8-9.

New claims 166 and 167 recite the treatment of a host, and treatment of a human infected with a hepatitis C virus. Support for these claims is found, for example, in the specification at page 54, lines 9-17.

New claims 168-171 recite methods of contacting a virus or cell in a host with a compound of the instant claims. Support for these claims is found, for example, in the specification at page 7, lines 10-12, and page 54, lines 9-17.

Claims Objections

The Examiner has objected to claim 144 for allegedly being in improper dependent form. (Office Action, page 3). Specifically, the Examiner alleges that claim 144 does not further limit claim 130. (*Id.*). Applicants point out that claim 144 recites the method of claim 130, wherein the β -D-2'-methyl-ribofuranosyl nucleoside is administered, as opposed to the corresponding phosphate, salt, or ester. Thus, as claim 144 limits claim 130 to the administration of the compound only, claim 144 is in proper dependent form.

The Examiner has also objected to claims 147 and 150 as allegedly being substantial duplicates of claims 131 and 132, respectively. (*Id.*). Claims 147 and 150 are not substantial duplicates of claims 131 and 132 for the same reasons stated above with regard to claim 144.

The Examiner has objected to claims 158-160 for depending from a withdrawn claim. Claims 158-160 have been canceled, therefore, this objection is moot.

Obviousness-Type Double Patenting Rejections

A. U.S. Patent Nos. 6,812,219; 7,148,206 and 7,105,493.

Claims 130-131 and 137-149 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over the claims of U.S. Patent Nos. 6,812,219; 7,148,206; and 7,105,493. Applicants respectfully disagree with this rejection and the Examiner's reasoning supporting the rejection. However, solely to promote allowance of the instant application, submitted concurrently herewith are executed Terminal Disclaimers over U.S. Patent Nos. 6,812,219; 7,148,206; and 7,105,493 for filing in connection with the above-referenced application.

Applicants respectfully point out that the filing of a terminal disclaimer is not an admission of the propriety of the rejection. *See* MPEP § 804.02; *Quad Environmental Technologies Corp. v. Union Sanitary District*, 949 F.2d 870 (Fed Cir. 1991). Applicant respectfully submits that submission of the Terminal Disclaimers places the application in condition for allowance.

B. Provisional Obviousness-Type Double Patenting Rejections over U.S. Patent Application Nos. 10/609,298; 11/005,440; 11/005,443; 11/005,444; 11/005,446 and 11/005,466.

The Examiner has maintained the rejection of the instant claims over the claims of U.S. Patent Application Nos. 10/609,298; 11/005,440; 11/005,443; 11/005,444; 11/005,446 and 11/005,466. Applicants respectfully disagree with this rejection and the Examiner's reasoning supporting the rejection.

If provisional obviousness-type double patenting rejections are the only rejections remaining in an earlier filed pending application, the Examiner should withdraw those rejections and permit the earlier-filed application to issue as a patent without a Terminal Disclaimer. Manual of Patent Examination Procedure § 804, subsection I.B.

The filing date of the instant application is June 20, 2003. The filing date of U.S. Patent Application No. 10/609,298 is June 27, 2003. The filing date of each of U.S. Patent Application Nos. 11/005,440; 11/005,443; 11/005,444; 11/005,446 and 11/005,466 is December 6, 2004. Therefore, because the instant application is the earlier-filed application, and only provisional obviousness-type double patenting rejections remain, Applicants

respectfully request that the Examiner withdraw the rejections and allow the instant application to issue as a patent without a Terminal Disclaimer over these applications.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

No fee is believe to be due with this submission, however, if deemed necessary, please apply any fees or credits to Jones Day Deposit Account No. 503013 (ref. no. 417451-999043).

If the Examiner believes it would be useful to advance prosecution, the Examiner is invited to telephone the undersigned at (858) 314-1200.

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Respectfully submitted,



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